

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re the Application of William A. Royall, et al.

Serial No.: 09/961,234

Art Unit No.: 2162

Filed: September 24, 2001

Examiner: Jean M. Corrielus

Title: **METHOD OF GENERATING INCREASED APPLICATIONS FOR  
ENROLLMENT AT EDUCATIONAL INSTITUTIONS**

**TRANSMITTAL**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Transmitted herewith is a Petition to Revive the Application Under 37 CFR § 1.137(b), Exhibit A (Notice of Appeal, Pre-Appeal Brief Request for Review; a copy of a Response filed on May 18, 2007) and Exhibit B (copy of Pre-Appeal Brief Request for Review filed on November 17, 2007) for the above-identified application.

The Commissioner is hereby authorized to charge \$995.00 (Notice of Appeal and Petition to Revive Unintentional Abandoned Application fees) and any additional fees associated with this communication or credit any overpayment to **Deposit Account No. 04-1679**.

Respectfully submitted,

/mcc/

Mark C. Comtois

Reg. No. 46,285

DUANE MORRIS LLP  
505 9<sup>th</sup> Street, N.W., Suite 1000  
Washington, D.C. 20004  
Telephone: (202) 776-7800  
Facsimile: (202) 776-7801  
Dated: 28 February 2008

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re the Patent Application of William A. ROYALL, Jr. et al.

Serial No.: 09/961,234

Art Unit: 2162

Filed: September 24, 2001

Examiner: Jean M. Corrielus

Title: METHOD OF GENERATING INCREASED APPLICATIONS FOR  
ENROLLMENT AT EDUCATIONAL INSTITUTIONS

**Office of Petitions**

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

**PETITION TO REVIVE THE APPLICATION**  
**UNDER 37 CFR § 1.137(b)**

Sir:

This communication is responsive to the Notice of Abandonment for the subject application mailed February 4, 2008.

Applicant hereby petitions the Office under 37 CFR §1.137(b) to revive the subject application that was unintentionally abandoned for failure to timely respond to a final Office Action.

Applicant submits herewith:

- a. a Notice of Appeal and Pre-Appeal Brief Request for Review in response to the final Office Action dated May 18, 2007 and Advisory Action dated September 7, 2007 as Exhibit A;

b. the Petition Fee as set forth in 37 CFR § 1.17(m);

The undersigned hereby states that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional.

The Applicant filed a Pre Appeal Brief Request for Review on November 17, 2007, the filing receipt of which is provided as Exhibit B. However, the Applicant unintentionally failed to include a Notice of Appeal, as a result the Pre Appeal Brief Request was not entered.

Favorable consideration of this petition and acceptance of Notice of Appeal and Pre-Appeal Brief Request for Review is solicited.

Should any additional fees be necessary in connection with the filing of this Petition, or if a petition for extension of time is required for timely acceptance of the same, such a petition is made and the Office is authorized to charge such fees to **Deposit Account No. 04-1679**.

Respectfully submitted,

/mcc/

Mark C. Comtois	Reg. No. 46,285
Patrick C. Muldoon	Reg. No. 47,343

DUANE MORRIS LLP  
505 9th Street, N.W., Suite 1000  
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Telephone: (202) 776-7800  
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Dated: February 28, 2008

## EXHIBIT A

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re the Patent Application of William A. ROYALL, Jr. et al.

Serial No.: 09/961,234

Art Unit: 2162

Filed: September 24, 2001

Examiner: Jean M. Corrielus

Title: METHOD OF GENERATING INCREASED APPLICATIONS FOR  
ENROLLMENT AT EDUCATIONAL INSTITUTIONS

**Mail Stop AF**  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**NOTICE OF APPEAL**

Sir:

All finally rejected claims in the decision of the Examiner dated May 18, 2007  
and Advisory Action dated September 7, 2007, are hereby appealed to the Board of  
Patent Appeals and Interferences.

Respectfully Submitted,

/mcc/

Mark C. Comtois

Reg. No. 46,285

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Telephone: (202) 776-7800  
Telecopier: (202) 776-7801  
Dated: February 28, 2008

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re the Patent Application of: William A. ROYALL, Jr., et al.

Confirmation No.: 6263

Serial No.: 09/961,234

Art Unit: 2162

Filed: September 24, 2001

Examiner: Jean M. Corrielus

Title: **METHOD OF GENERATING INCREASED APPLICATIONS FOR  
ENROLLMENT AT EDUCATIONAL INSTITUTIONS**

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Applicant respectfully requests review of the final rejection in the above-identified application in view of the following remarks.

## REMARKS

**I. The rejection of Claims 6 and 12-14 under §102(b) is improper as Noël-Levitz does not disclose each and every limitation in the claims.**

1. The Office acknowledges that Noël-Levitz does not disclose each and every limitation. The Office states that “Noël-Levitz does not explicitly provide a web site containing links to a survey and to a partial application; assigning a unique access number (“PIN”) to each candidate in the target group; electronically mailing each candidate in the target group the assigned PIN and an invitation to use the PIN to access the website; providing each candidate accessing the web site and indicating a continuing interest in the education institution with electronic access to the partial application; for each candidate who electronically accesses the partial application” as required in Claim 12 and similarly Claim 13. See Office Action, May 18, 2007, pages 3 and 4.

2. The Office does not attempt to rely on inherency but rather hints at obviousness and brings in additional references in an attempt to correct the deficiencies as discussed in the Applicants’ Response of August 17, 2007, page 6.

3. Noël-Levitz does not disclose a partial application or the steps involving a partial application as recited in the claims. See Applicant’s response of August 17, 2006, pages 6 and 7.

4. Noël-Levitz does not disclose customizing the partial application or any type of application with personal information from the database.

The Office cites pages 18 and 19 “making [it] all work together” of Noël-Levitz as the basis of disclosure for this limitation. However, even the most imaginative reading of pages 18 and 19, would fail to provide such a teaching. The mere fact of data being recorded throughout the processes is not a teaching of using that data to customize a partial application, as required in Claims 12 and 13. In fact Noël-Levitz teaches what to do with the data, “Information mined from the data being gathered should be used to target admissions travel, select tele-counseling prospects, segment direct mail programs, build interest in special events, and predict enrollment trends while there is still time to intervene.” Noël-Levitz, page 19. This data is not nor could it be used to customize partial applications.

5. Noël-Levitz does not disclose all of the limitations in the claim and fails to provide a disclosure of a partial application and associated operations, thus the anticipated rejection by the Office is improper.

**II. The § 103 rejection of Claims 6 and 12-14 is improper because the Office’s relies on the disclosure of Noël-Levitz for limitations that are simply not disclosed in Noël-Levitz.**

1. Noël-Levitz does not disclose a partial application or the steps involving a partial application as recited in the claims. See Applicant’s response of August 17, 2007, pages 6 and 7.

2. Noël-Levitz does not disclose customizing the partial application or any type of application with personal information from the database. See I.(4) above

3. Noël Levitz does not disclose a “partial application” separate and apart from “a full application” as recited in Claim 12 and therefore cannot meet all the relied upon claim



limitations relied upon by the Office. *See* Applicants' response of August 17, 2007, page 7, last paragraph; *See also* Applicants' response of March 1, 2007, page 6, last paragraph.

4. The Office's reliance on the statement "Noël-Levitz continually update the prospective interest profile with each contact (pages 4 and 5), wherein the qualifying codes help rate and track the prospects interest in the institution at various stages of the recruiting process (pages 18 and 19)" Office Action of May 18, 2007, pages 4 and 6 to both meet and then render obvious the limitations of "provide a web site containing links to a survey and to a partial application; assigning a unique access number ("PIN") to each candidate in the target group; electronically mailing each candidate in the target group the assigned PIN and an invitation to use the PIN to access the website; providing each candidate accessing the web site and indicating a continuing interest in the education institution with electronic access to the partial application; for each candidate who electronically accesses the partial application", Office Action of May 17, 2007, page 4, as required in Claim 12 and similarly Claim 13 is so completely without merit the Applicant is at a loss for words. *See* Applicant's response of March 1, 2007, pages 3 and 4.

**III. The § 103 rejection of Claims 6 and 12-14 is improper because the Office relies on teaching in the prior art that are not present or do not obviate the deficiencies of Noël-Levitz.**

1. Schillewaert does not disclose what the Office purports. The Office reliance on Schillewaert to provide the limitations that "**Noël-Levitz does not explicitly provide**" is without any merit. *See* Applicant's response of March 1, 2007, page 5.

2. The addition of Thomas does not obviate the deficiencies of what “Noël-Levitz does not explicitly provide”. See Applicant’s response of March 1, 2007, page 6.

#### IV. Conclusion

The Applicant requests review of the Final Rejection and withdrawal of the rejections in view of the above comments and the Applicant’s previous responses. The Applicant also request allowance of the Application including claims.

Respectfully submitted,

/mcc/

Mark C. Comtois

Reg. No. 46,285

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1667 K Street, N.W., Suite 700  
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Date: February 28, 2008

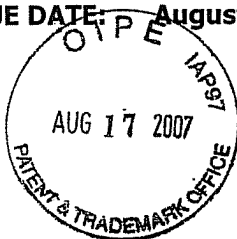
**Today's Date: August 17, 2007**

**Atty Docket:** ROY03 001  
**Applicant(s):** ROYALL, et al.  
**Serial No.:** 09/961,234  
**Filing Date:** September 24, 2001  
**Title:** METHOD OF GENERATING INCREASED APPLICATIONS FOR  
ENROLLMENT AT EDUCATIONAL INSTITUTIONS

The following has been received in the U.S. Patent & Trademark Office on the date  
stamped hereon:

X	Transmittal (in duplicate)
X	Response to Office Action dated May 18, 2007

**DUE DATE: August 18, 2007**



**Duane Morris LLP**  
**1667 K Street, NW**  
**Washington, DC 20006**  
**(202) 776-7800**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re the Application of William A. Royall, et al.

Serial No.: 09/961,234

Art Unit No.: 2162

Filed: September 24, 2001

Examiner: Jean M. Corrielus

Title: METHOD OF GENERATING INCREASED APPLICATIONS FOR  
ENROLLMENT AT EDUCATIONAL INSTITUTIONS

**TRANSMITTAL**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

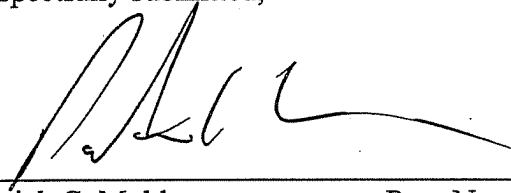
Transmitted herewith is a Response to the Office Action dated May 18, 2007 for the  
above-identified application.

If a Petition for an Extension of Time is necessary for the papers transmitted herewith to  
be timely filed, this transmittal is to be considered as a petition to extend the period by the  
amount of time needed for the papers to be timely filed.

The Commissioner is hereby authorized to charge payment of any additional fees  
associated with this communication or credit any overpayment to **Deposit Account No. 04-  
1679.**

A duplicate of this sheet is enclosed.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'P. Muldoon', written over a horizontal line.

Patrick C. Muldoon

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Dated: 17 August 2007

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re the Application of William A. Royall, et al.

Serial No.: 09/961,234

Art Unit No.: 2162

Filed: September 24, 2001

Examiner: Jean M. Corrielus

Title: METHOD OF GENERATING INCREASED APPLICATIONS FOR  
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**TRANSMITTAL**

Commissioner for Patents  
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Sir:

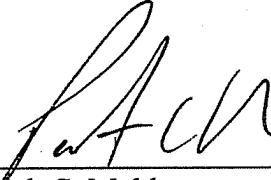
Transmitted herewith is a Response to the Office Action dated May 18, 2007 for the above-identified application.

If a Petition for an Extension of Time is necessary for the papers transmitted herewith to be timely filed, this transmittal is to be considered as a petition to extend the period by the amount of time needed for the papers to be timely filed.

The Commissioner is hereby authorized to charge payment of any additional fees associated with this communication or credit any overpayment to **Deposit Account No. 04-1679.**

A duplicate of this sheet is enclosed.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Patrick C. Muldoon', written over a horizontal line.

Patrick C. Muldoon

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Facsimile: (202) 776-7801

Dated: 17 August 2007

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re the Patent Application of William A. Royall, et al

Serial No.: 09/961,234

Art Unit: 2162

Filed: September 24, 2001

Examiner: Jean M. Corrielus

Title: METHOD OF GENERATING INCREASED APPLICATIONS FOR  
ENROLLMENT AT EDUCATIONAL INSTITUTIONS

**AMENDMENT**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

Sir:

In response to the Office Action dated May 18, 2007, Applicants submits the following amendments and remarks.

**Amendments** begin on Page 2.

**Remarks** begin on Page 5.



### Amendment to the Claims

1-5 (Cancelled)

6. (Previously Presented) The method of Claim 12 wherein the incentive is selected using criteria established by the educational institution for the target group.

7-11 (Cancelled)

12. (Currently Amended) A method for generating applications from candidates interested in attending an educational institution comprising the steps of:

- (a) accessing a candidate database containing personal information;
- (b) profiling the candidates according to criteria established by the educational institution;
- (c) segmenting the profiled candidates into a target group;
- (d) providing a web site containing links to a survey and to a partial application;
- (e) assigning a unique access number ("PIN") to each candidate in the target group;
- (f) electronically mailing each candidate in the target group the assigned PIN and an invitation to use the PIN to access the web site;
- (g) providing each candidate accessing the web site and indicating a continuing interest in the educational institution with electronic access to the partial application;

- (h) for each candidate who electronically accesses the partial application, customizing the partial application with personal information from the database;
- (i) compiling the partial applications which have been electronically completed;
- (j) transmitting the partial applications to the educational institution;
- (k) providing a personalized acknowledgement of each partial application received;
- (l) updating the database with information from the partial application;
- (m) inviting each candidate to submit a full application;
- (n) providing electronic access through use of the PIN to a full application customized with personal information from the updated database; and,
- ~~(n)~~(o) offering each candidate invited to submit a complete application an incentive to submit the full application.

13. (Currently Amended) A method for generating electronic applications from candidates who respond to a web based survey consisting of the following steps:

- (a) accessing a database containing information related to candidates who have expressed an interest in attending an educational institution;
- (b) assigning a unique access number ("PIN") to each candidate;
- (c) electronically mailing each candidate a personalized communication that contains the assigned PIN and invites the candidate to use the assigned PIN to access a web based survey;
- (d) updating the database with information from the web based survey;

- (e) providing each candidate who indicates a continuing interest in the educational institution with the opportunity to access a partial application form customized with information from the updated database; ~~and~~
- (f) compiling and forwarding partial applications to the educational institution
- (g) updating the database with information from the partial application;
- (h) acknowledging completion of the partial application;
- (i) providing electronic access through use of the PIN to a full application customized with personal information from the updated database; and,
- (j) offering each candidate invited to submit a complete application an incentive to submit the full application.

14. (Previously Presented) The method of Claim 13, wherein the incentive is selected using criteria established by the educational institution for the target group.

## REMARKS

Claims 6 and 12-14 are currently pending in the present application. Claims 12-13 have been amended to correct minor claim language informalities. Claim 13 is objected and Claims 6 and 12-14 have been rejected.

## CLAIM OBJECTIONS

Claim 13 is objected to for containing a minor claim language informality. Applicant has amended Claim 13 in accordance with the Examiner's suggestion. Accordingly, Applicant requests the objection to Claim 13 be withdrawn.

## REJECTIONS UNDER 35 U.S.C.

§102(b), and in the alternative §103(a)

Claims 6 and 12-14 were rejected under §102(b) as being anticipated by, or, in the alternative, under §103(a) as obvious over 'Noel-Levitz' ([www.noellelevitz.com](http://www.noellelevitz.com)) Newsletter archive, Grading and Qualifying Prospects, winter 1998 (part 1) and spring 1998 (part 2). Applicant submits that these rejections are improper and must be withdrawn.

As stated previously in the Response dated March 1, 2007, the Office Acknowledges “Noel-Levitz does not explicitly provide a web site containing links to a survey and to a partial application; assigning a unique access number (“PIN”) to each candidate in the target group: electronically mailing each candidate in the target group the assigned PIN and an invitation to use the PIN to access the web site; providing each candidate accessing the web site and indicating a continued interest in the educational institution with electronic access to the partial application; for each candidate who electronically accesses the partial application.”

In addition to the admitted deficiencies of Noel-Levitz, the Examiner has remarked on page 12 of the Final Rejection dated May 5, 2007 that the alleged anticipation rejection of Claims 6, and 12-14 requires one or more references: Dugan et al., Using GMAC...pp. 24-31, and U.S. Patents 6,256,614 and 5,774,869 to support the deficiencies of Noel-Levitz. Anticipation as defined under 35 U.S.C. §102(b) requires a single reference teach all of the limitations of a single claim. For at least that reason, examiner’s rejection under 35 U.S.C. §102(b) is improper and must be withdrawn.

Notwithstanding the improper rejection under 35 U.S.C. §102(b). Noel-Levitz does not teach, disclose or render obvious the claimed features of Claim 12.

Examiner alleges on page 3 of the Final Rejection that Noel-Levitz discloses several claim operations of Claim 12 which reference a “partial application”, and relies on pages 4-6, and 16-20 for support. Applicant has reviewed these portions of Noel-

Levitz cited by examiner, and can find no support for a “partial application” as described in claim 12, which recites, in part:

- (h) for each candidate who electronically accesses the partial application, customizing the partial application with personal information from the database;
- (i) compiling the partial applications which have been electronically completed;
- (j) transmitting the partial applications to the educational institution;
- (k) providing a personalized acknowledgement of each partial application received;
- (l) updating the database with information from the partial application.

Noel-Levitz is directed to profiling prospective applicants in an effort to increase the efficiency of staff and university resources. The information is mined to invoke recruiting resources, such as: admissions travel, telecounseling, direct mailings, special event planning, and to predict enrollment trends. The disclosure of Noel-Levitz is based on receiving pre-existing applicant information stored in a database. The Noel-Levitz system does not include any reference to “partial applications” as described in Claim 12.

In contrast to the disclosure of Noel-Levitz, Claim 12 recites a plurality of method operations ((d) and (g)-(l)) which specifically refer to a “partial application”, and which are part of the method for generating applications from candidates interested in attending an educational institution, as recited in Claim 12. Further, operations (m)-(n) of Claim 12 specifically recite a “full application” separate from the “partial application.” Noel-Levitz makes no reference to any varying stages of application completeness.

Referring to the specification for support, a truncated application is explicitly described on page 16 of present application. Paragraph 3, page 16 of the specification recites: “The application itself may be truncated because information known to the institution about the candidate through the inquiry pool profiling procedure need not be again requested in the application.” The truncated application may include portions not completed, however, more importantly, the truncated application may not include portions already completed. Noel-Levitz does not teach or disclose a “partial” application, or as the specification recites a “truncated” application.

In addition to the multiple references to the “partial application” in Claim 12, a few example operations of Claim 12 include: customizing, compiling and updating, among other operations, which specifically refer to the “partial application.” Noel-Levitz makes no reference to a “partial application” and there is no indication of any particular handling operations that refer specifically to the “partial application” as recited in Claim 12.

In relying on the teachings of Noel-Levitz the Examiner has failed to teach all of the claim limitations of Claim 12, and more specifically, has omitted the “partial application” element recited in operations ((d) and (g)-(l)) of Claim 12. The rejection to Claim 12 is improper and must be withdrawn.

The withdrawal of the rejection to Claim 12 and an allowance thereof are kindly requested.

With regard to Claims 6 and 13-14, Applicant submits that independent Claim 13 is also allowable over Noel-Levitz for at least the reasons stated above with regard to

Claim 12. Further, dependent claims 6 and 14 by virtue of dependency are also in condition for allowance. Withdrawal of all outstanding rejections to Claims 6 and 12-14, and an allowance thereof are kindly requested.

### CONCLUSION

The Office has failed to demonstrate that Noel-Levitz discloses each and every feature of the claimed subject matter and has failed to provide a *prima facie* case of obviousness. Each element recited in the claims have not been met by the references alone or in combination. The Applicants request withdrawal of the rejections, and if the rejections are maintained, an element by element accounting of the claim terms in the cited art. Applicant believes that the present application is now in condition for allowance and such action is earnestly requested.

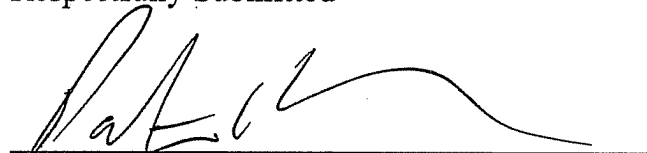
If the Examiner has any questions relating to this Amendment or the application in general he is respectfully requested to contact the undersigned so that prosecution may be expedited.

Applicant believes that the present application is now in condition for allowance and such action is earnestly requested.



Should any additional fees be necessary in connection with the filing of this Amendment, or if a petition for extension of time is required for timely acceptance of the same, such a petition is made and the Office is authorized to charge such fees to **Deposit Account No. 04-1679.**

Respectfully Submitted



---

Patrick C. Muldoon

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1667 K Street, N.W., Suite 700  
Washington, DC 20006  
Telephone: (202) 776-7800  
Telecopier: (202) 776-7801

Dated: August 17, 2007

## EXHIBIT B

**Today's Date: 15 November 2007**

**Attorney Docket: ROY03 001**

**Applicant: WILLIAM A. ROYALL, JR. *et al.***

**Serial No.: 09/961,234**

**Art Unit: 2162**

**Filed: SEPTEMBER 21, 2001**

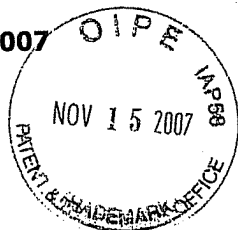
**Examiner: JEAN M. CORRIELUS**

**Title: METHOD OF GENERATING INCREASED APPLICATIONS FOR  
ENROLLMENT AT EDUCATIONAL INSTITUTIONS**

These items were received in the U.S. Patent and Trademark Office on the date stamped hereon:

<input checked="" type="checkbox"/>	Transmittal (in duplicate, 2 pages)
<input checked="" type="checkbox"/>	Pre-Appeal Brief Request for Review (5 pages)

**Due Date: NOVEMBER 18, 2007**



**DM2\1306312.1**

**Duane Morris LLP  
1667 K Street, N.W. Suite 700  
Washington, DC 20006-1608  
(202) 776-7800**

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

## TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Total Number of Pages in This Submission

7

Application Number

09/961,234

Filing Date

SEPTEMBER 24, 2001

First Named Inventor

ROYALL, WILLIAM A., JR.

Art Unit

2162

Examiner Name

CORRIELUS, JEAN M.

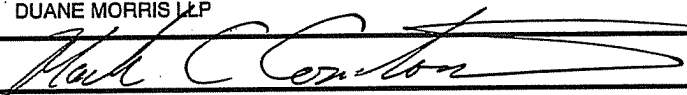
Attorney Docket Number

ROY03 001

### ENCLOSURES (Check all that apply)

<input type="checkbox"/> Fee Transmittal Form	<input type="checkbox"/> Drawing(s)	<input type="checkbox"/> After Allowance Communication to TC
<input type="checkbox"/> Fee Attached	<input type="checkbox"/> Licensing-related Papers	<input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences
<input checked="" type="checkbox"/> Amendment/Reply	<input type="checkbox"/> Petition	<input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief)
<input checked="" type="checkbox"/> After Final	<input type="checkbox"/> Petition to Convert to a Provisional Application	<input type="checkbox"/> Proprietary Information
<input type="checkbox"/> Affidavits/declaration(s)	<input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address	<input type="checkbox"/> Status Letter
<input type="checkbox"/> Extension of Time Request	<input type="checkbox"/> Terminal Disclaimer	<input type="checkbox"/> Other Enclosure(s) (please identify below):
<input type="checkbox"/> Express Abandonment Request	<input type="checkbox"/> Request for Refund	DUPLICATE OF THIS TRANSMITTAL
<input type="checkbox"/> Information Disclosure Statement	<input type="checkbox"/> CD, Number of CD(s) _____	
<input type="checkbox"/> Certified Copy of Priority Document(s)	<input type="checkbox"/> Landscape Table on CD	
<input type="checkbox"/> Reply to Missing Parts/Incomplete Application	<b>Remarks</b>	
<input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53	PRE-APPEAL BRIEF REQUEST FOR REVIEW.	

### SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name	DUANE MORRIS LLP		
Signature			
Printed name	MARK C. COMTOIS DOC# DM2\1306316.1		
Date	NOVEMBER 15, 2007	Reg. No.	46,285

### CERTIFICATE OF TRANSMISSION/MAILING

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below:

Signature			
Typed or printed name		Date	

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Application Number

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First Named Inventor

ROYALL, WILLIAM A., JR.

Art Unit

2162

Examiner Name

CORRIELUS, JEAN M.

Attorney Docket Number

ROY03 001


### ENCLOSURES (Check all that apply)

<input type="checkbox"/> Fee Transmittal Form	<input type="checkbox"/> Drawing(s)	<input type="checkbox"/> After Allowance Communication to TC
<input type="checkbox"/> Fee Attached	<input type="checkbox"/> Licensing-related Papers	<input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences
<input checked="" type="checkbox"/> Amendment/Reply	<input type="checkbox"/> Petition	<input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief)
<input checked="" type="checkbox"/> After Final	<input type="checkbox"/> Petition to Convert to a Provisional Application	<input type="checkbox"/> Proprietary Information
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#### Remarks

PRE-APPEAL BRIEF REQUEST FOR REVIEW.

### SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name	DUANE MORRIS LLP		
Signature			
Printed name	MARK C. COMTOIS DOC# DM2\1306316.1		
Date	NOVEMBER 15, 2007	Reg. No.	46,285

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ATTORNEY DOCKET NO. ROY03 001

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re the Patent Application of: William A. ROYALL, Jr., et al.

Confirmation No.: 6263

Serial No.: 09/961,234

Art Unit: 2162

Filed: September 24, 2001

Examiner: Jean M. Corrielus

Title: **METHOD OF GENERATING INCREASED APPLICATIONS FOR  
ENROLLMENT AT EDUCATIONAL INSTITUTIONS**

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Applicant respectfully requests review of the final rejection in the above-identified application in view of the following remarks.

## REMARKS

**I. The rejection of Claims 6 and 12-14 under §102(b) is improper as Noël-Levitz does not disclose each and every limitation in the claims.**

1. The Office acknowledges that Noël-Levitz does not disclose each and every limitation. The Office states that “Noël-Levitz does not explicitly provide a web site containing links to a survey and to a partial application; assigning a unique access number (“PIN”) to each candidate in the target group; electronically mailing each candidate in the target group the assigned PIN and an invitation to use the PIN to access the website; providing each candidate accessing the web site and indicating a continuing interest in the education institution with electronic access to the partial application; for each candidate who electronically accesses the partial application” as required in Claim 12 and similarly Claim 13. See Office Action, May 18, 2007, pages 3 and 4.

2. The Office does not attempt to rely on inherency but rather hints at obviousness and brings in additional references in an attempt to correct the deficiencies as discussed in the Applicants’ Response of August 17, 2007, page 6.

3. Noël-Levitz does not disclose a partial application or the steps involving a partial application as recited in the claims. See Applicant’s response of August 17, 2006, pages 6 and 7.

4. Noël-Levitz does not disclose customizing the partial application or any type of application with personal information from the database.

The Office cites pages 18 and 19 “making [it] all work together” of Noël-Levitz as the basis of disclosure for this limitation. However, even the most imaginative reading of pages 18 and 19, would fail to provide such a teaching. The mere fact of data being recorded throughout the processes is not a teaching of using that data to customize a partial application, as required in Claims 12 and 13. In fact Noël-Levitz teaches what to do with the data, “Information mined from the data being gathered should be used to target admissions travel, select tele-counseling prospects, segment direct mail programs, build interest in special events, and predict enrollment trends while there is still time to intervene.” Noël-Levitz, page 19. This data is not nor could it be used to customize partial applications.

5. Noël-Levitz does not disclose all of the limitations in the claim and fails to provide a disclosure of a partial application and associated operations, thus the anticipated rejection by the Office is improper.

**II. The § 103 rejection of Claims 6 and 12-14 is improper because the Office’s relies on the disclosure of Noël-Levitz for limitations that are simply not disclosed in Noël-Levitz.**

1. Noël-Levitz does not disclose a partial application or the steps involving a partial application as recited in the claims. See Applicant’s response of August 17, 2007, pages 6 and 7.

2. Noël-Levitz does not disclose customizing the partial application or any type of application with personal information from the database. See I.(4) above

3. Noël Levitz does not disclose a “partial application” separate and apart from “a full application” as recited in Claim 12 and therefore cannot meet all the relied upon claim



limitations relied upon by the Office. *See* Applicants' response of August 17, 2007, page 7, last paragraph; *See also* Applicants' response of March 1, 2007, page 6, last paragraph.

4. The Office's reliance on the statement "Noël-Levitz continually update the prospective interest profile with each contact (pages 4 and 5), wherein the qualifying codes help rate and track the prospects interest in the institution at various stages of the recruiting process (pages 18 and 19)" Office Action of May 18, 2007, pages 4 and 6 to both meet and then render obvious the limitations of "provide a web site containing links to a survey and to a partial application; assigning a unique access number ("PIN") to each candidate in the target group; electronically mailing each candidate in the target group the assigned PIN and an invitation to use the PIN to access the website; providing each candidate accessing the web site and indicating a continuing interest in the education institution with electronic access to the partial application; for each candidate who electronically accesses the partial application", Office Action of May 17, 2007, page 4, as required in Claim 12 and similarly Claim 13 is so completely without merit the Applicant is at a loss for words. *See* Applicant's response of March 1, 2007, pages 3 and 4.

**III. The § 103 rejection of Claims 6 and 12-14 is improper because the Office relies on teaching in the prior art that are not present or do not obviate the deficiencies of Noël-Levitz.**

1. Schillewaert does not disclose what the Office purports. The Office reliance on Schillewaert to provide the limitations that "Noël-Levitz does not explicitly provide" is without any merit. *See* Applicant's response of March 1, 2007, page 5.

2. The addition of Thomas does not obviate the deficiencies of what ““Noël-Levitz does not explicitly provide”. See Applicant’s response of March 1, 2007, page 6.

#### IV. Conclusion

The Applicant requests review of the Final Rejection and withdrawal of the rejections in view of the above comments and the Applicant’s previous responses. The Applicant also request allowance of the Application including claims.

Respectfully submitted,



Mark C. Comtois

Reg. No. 46,285

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